

REMARKS

The Office Action mailed September 23, 2002 has been carefully considered.

The undersigned attorney wishes to acknowledge with much appreciation the courteous interview afforded him by Examiner J. Casimer Jacyna on October 3, 2002. During this interview the outstanding Office Action was discussed. It was agreed that Applicant would amend the specification to more clearly provide antecedent basis for certain claim language, which finds support in the originally filed drawings, to overcome the 35 U.S.C. § 112 rejections. Applicant's attorney also contended that the outstanding rejections under 35 U.S.C. § 251 were improper as the amended claims were narrowed in certain respects with regards to the seal recitations and therefore clearly fell within the ambit of an exception to the "recapture rule." While no final agreement was reached, the Examiner agreed to reconsider the issue if represented in a response to the outstanding Office Action.

Applicant acknowledges with much appreciation the allowance of claims 1-26 and 77.

Applicant will surrender the original patent upon the indication that the application is in condition for allowance.

The specification has been objected to as failing to provide proper antecedent basis for certain terms in the claimed subject matter. The above amendment to the specification provides antecedent basis for these terms. Support for the amendment is found in Fig. 2 of the drawings.

Claims 27-36, 38-54, 71-76 and 78 are rejected under 35 U.S.C § 112 as containing subject matter which was not adequately described in the specification and as being indefinite. The above amendment to the specification provides adequate description for the claimed subject matter and renders the claims definite in compliance with 35 U.S.C. § 112.

Claims 71-76 and 78 are rejected under 35 U.S.C. § 251 as being "an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based." In particular, the Examiner contends that since claims 71-78 do not include a limitation that the lid either "seals against an

outside of said spout” or is “arranged to seal around an outside of said spout”, that these claims recapture previously surrendered subject matter. For reasons discussed during the interview and as set forth below, it is respectfully submitted that the rejection of claims 71-76 and 78 under 35 U.S.C. § 251 is inappropriate.

The Examiner’s attention is specifically invited in M.P.E.P. §1412.02 to the section entitled “REISSUE CLAIMS ARE BROADER IN SCOPE IN SOME ASPECTS, BUT NARROWER IN OTHERS:” (page 1400-15 of the Original Eighth Edition, August, 2001). For reasons that will be herein discussed, this section of the M.P.E.P. is applicable to the present facts. This section provides clear guidance with respect to a factual situation that avoids the effect of the recapture rule. In particular, the recapture rule is avoided if the reissue claims are broader in certain aspects and narrower in others vis-a-vis claims cancelled from the original application to obtain a patent “if the claims are broader in a way that does not attempt to reclaim what was surrendered earlier.” Mentor Corp. V. Coloplast, Inc. 998 F.2d 992,994, 27 USPQ 1521, 1525 (Fed. Cir. 1993). The Hester Industries, Inc. case, cited by the Examiner in the Official Action, references the Mentor Corp. case and states “[F]inally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects.” Also, the cited In re Clement case and the Ball Corp. case each recognize this basis of avoiding the “recapture rule.”

Turning to the facts of the present case, the Examiner has properly observed that the claims 1, 13, 18 and 22, of U.S. Patent No. 5,938,087, include a recitation to the effect that the seal is located against or around an outside surface of the spout and that this particular locational relationship of the seal is not recited in reissue application claims 71-76 and 78. However, the Examiner’s assertion that this limitation was a “primary reason for allowing all of the claims” of U.S. Patent No. 5,938,087 over Song and other prior art, is not supported by the Examiner’s statement of reasons for allowance in the Notice of Allowability document in the application that issued as U.S. Patent No. 5,938,087. That document sets forth numerous reasons for allowance, but none of them relate to the lid sealing on the outside of the spout. Accordingly, it is most apparent that the Examiner did not deem the lid seal recitations to be one of the

"primary reasons" for allowing the claims.

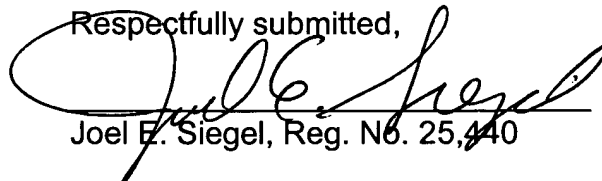
Claims 71-76 and 78 further define the seal between the lid and the spout as including (a) a continuously curving first sealing surface on the spout, (b) a sealing element on the lid defining a continuous curving second sealing surface, and (c) a surface-to-surface contact between the first and second sealing surfaces when the lid is in its closed position. These specific recitations are not present in any of the claims in U.S. Patent No. 5,938,087. Accordingly, while claims 71-76 and 78 in certain respects define the seal between the lid and the spout more broadly (e.g., the seal not being limited to a location against the outside of the spout), these claims also define this same seal more narrowly in a material respect (recitations a-c above).

As set forth above, the "recapture rule" may be avoided in instances where the reissue claims are broader in certain respects and narrower in other respects. In view of the above discussion, it is respectfully submitted that claims 71-76 and 78 have been materially narrowed with respect to the limitation of the alleged recapture (the seal between the lid and the spout) so that the "recapture rule" is avoided. Accordingly, it is respectfully submitted that claims 71-76 and 78 are in compliance with 35 U.S.C. 251.

Applicant acknowledges the withdrawal of the rejection of claims 27, 38 and 47 under 35 U.S.C § 251. However, in so doing, the Examiner has apparently interpreted the scope of these claims as requiring sealing on the outside surface of the spout. As discussed during the interview, particularly as is now clearer from the amendments to the specification, these claims are not intended to require that the lid seal on the outside surface of the spout. Accordingly, the Examiner is requested to reconsider the status of these claims in light of the above discussions.

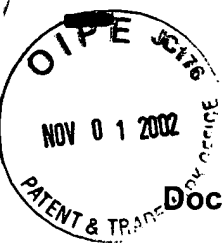
It is respectfully submitted that the application is now in condition for allowance.

Respectfully submitted,



Joel E. Siegel, Reg. No. 25,440

Wood, Phillips, Katz, Clark & Mortimer
500 West Madison Street, Ste. 3800
Chicago, IL 60661
312-876-1800



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Applicant(s): JEFFREY T. RANDALL

Serial No.: 09/915,132

Filing Date: 07/25/01

Invention: SPURT MINIMIZING DISPENSING STRUCTURE

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CERTIFICATE OF MAILING

I hereby certify that this Amendment and any other documents states as enclosed herewith (if applicable) is being deposited with the United States Postal Service with sufficient postage at First Class Mail in an envelope addressed to: Commissioner for Patents, BOX REISSUE, Washington, D.C. 20231 on **October 25, 2002**.


Carla Phillips